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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,698

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Michael E. Miller

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

08/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,698	Applicant(s) MILLER ET AL.	
	Examiner JONATHAN ML FOREMAN	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008 and 25 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 13-16 and 21-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 - 34 is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13, 14, 16, 21-29 and 31 is/are rejected.
- 7) ☒ Claim(s) 15 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/08 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

3. Claims 9, 11, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0077972 to Tsonton et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.

In regard to claims 9, 11, 13, 14 and 16, Tsonton et al. disclose a base; a cradle movably mounted to the base and an indexing guide moveable with the cradle and including a receptacle within which a portion of the medical instrument is received. The indexing guide includes a lip adjacent the receptacle. Tsonton et al. disclose a deployment mechanism configured to move the cradle relative to the base. However, Tsonton et al. fail to disclose two guide locks that selectively engage the portion of a medical received within the receptacle, the guide locks being slidably attached to the indexing guide and moveable axially through application of an axial force to the

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guide lock to inhibit rotation and axial movement. Moctezuma De La Barrera et al. teach two guide locks (122) that engages a portion of a medical instrument to inhibit rotation and axial movement, wherein the guide locks are slidably attached and moveable axially through application of an axial force to the guide lock and the medical instrument including at least one notch and the guide lock being configured to be received in the notch (Col. 6, lines 40 – 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the portion of the medical instrument received in the cradle to include at least one lock and to provide guide locks slidably attached and moveable axially through application of an axial force to the guide locks as taught by Moctezuma De La Barrera et al. in order to firmly engage the medical instrument so that a desired relationship is maintained between the medical instrument and the receptacle (Col. 6, lines 43 - 46).

4. Claims 9, 14 and 21 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.

In regard to claims 9, 14 and 21 – 24, Warner et al. disclose a base (12); a cradle (32) movably mounted to the base; and an indexing guide moveable with the cradle and including a receptacle (36) within which a portion of the medical instrument is received, the indexing guide including a guide lock (38) slidably attached to the indexing guide and selectively engagable with a portion of the medical instrument received within the receptacle to prevent rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein (Col. 4, lines 44 – 46). The guide lock is moveably secured to the indexing guide. The indexing guide includes a lip adjacent the receptacle (Figure 1). Warner et al. disclose a pivotable clamp (48) axially disposed a

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distance away from the guide lock that is selectively engagable with the medical instrument to inhibit rotation and axial movement (Col. 5, lines 7 – 9). Warner et al. disclose a guide lock that engages a portion of a medical instrument to inhibit rotation and axial movement, but fail to disclose the medical instrument including at least one notch and the guide lock being configured to be received in the notch to prevent movement of the medical instrument, the guide lock being moveable axially through application of an axial force to the guide lock. Moctezuma De La Barrera et al. teach a guide lock (122) that engages a portion of a medical instrument to inhibit rotation and axial movement, wherein the medical instrument including at least one notch and the guide lock being configured to be received in the notch, the guide lock being moveable axially through application of an axial force to the guide lock (Col. 6, lines 40 – 51). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Warner et al. and Moctezuma De La Barrera et al. teach means for locking a medical instrument within a receptacle, it would have been obvious to one skilled in the art at the time of the invention to substitute one guide lock for the other to achieve the predictable results of holding the medical instrument in a fixed relation to the receptacle.

5. Claims 25 – 29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al. as applied above, and further in view of DE 935,625 to Bodendieck et al.

In regard to claims 25 – 29 and 31, Warner et al. in view of Moctezuma De La Barrera et al. disclose the cradle allowing for rotatably supporting a medical device therein for positioning of the device and the medical instrument being a biopsy device (Col. 5, line 40), but fail to disclose the biopsy device having a handpiece and a cutting element having an outer hub, wherein the cutting

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element comprises an outer cannula connected to the outer cannula hub and defining a tissue receiving opening and an inner cannula disposed within the outer cannula and attached to the handpiece. Bodendieck et al. teach a biopsy device (Figures 1, 2, 3) having a handpiece and a cutting element having an outer hub, wherein the cutting element comprises an outer cannula (2) connected to the outer cannula hub (Figure 2) and defining a tissue receiving opening (Figure 8) and an inner cannula (3) disposed within the outer cannula and attached to the handpiece (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the biopsy device disclosed by Bodendieck et al. with the microdrive device taught by Warner et al. in view of Moctezuma De La Barrera et al. in order to permit safe and accurate placement of the biopsy device at the desired location (See Abstract).

Allowable Subject Matter

6. Claims 32 – 34 are allowed. Claims 15 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 6/26/08 have been fully considered but they are not persuasive. Applicant asserts that Warner et al. fail to disclose a lip adjacent the receptacle. However, the Examiner considers the upper surface of holding member (32) to be a lip. Applicant asserts that Moctezuma De La Barrera et al. disclose a channel and not a notch. However, the Examiner considers the channel to be a notch in that a channel is a concave cut or indentation in an edge or across a surface. In regard to Bodendieck et al. the Examiner considers the proximal portion of the inner cannula to be a handpiece in that a user could grip the proximal portion of the inner cannula.

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As such, the instrument holding member of Warner et al. would be capable of supporting the handpiece.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724.

The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736